

REMARKS

In the Final Office Action, the Examiner objected to the drawings; rejected claims 15 under 35 U.S.C. § 112, first paragraph; rejected claims 1, 3, 5, 6, 8, 10-12, and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,104,929 to Josse et al. (Josse) in view of U.S. Patent No. 7,310,331 to Sjoblom; rejected claims 4 under 35 U.S.C. § 103(a) as being unpatentable over Josse, Sjoblom, in view of U.S. Patent No. 6,735,834 to Miettinen et al. (Miettinen); and rejected claims 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Josse, Sjoblom, in view of U.S. Patent No. 6,792,270 to Neumann.

By this amendment, Applicants amend claims 1, 8, and 14 to more clearly define the features of those claim; amend claim 4, 6, and 12 to improve form; and cancel claims 3, 10, and 15 without prejudice or disclaimer.

Claims 1, 4-8, and 11-14 are currently pending.

Regarding the drawings, Applicants disagrees that FIGS. 1-3 depict "prior art" and nowhere does Applicants state that FIGS. 1-3 are prior art.

Regarding the rejection under 35 U.S.C. § 112, first paragraph, Applicant has canceled claim 15 to advance prosecution, without acquiescing to the propriety of the Examiner's rejection.

The Examiner rejected claims 1, 5, 6, 8, 11-12, and 14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,104,929 to Josse et al. (Josse) in view of U.S. Patent No. 7,310,331 to Sjoblom.¹ Applicants respectfully traverse this rejection.

Claim 1 defines a method comprising:

- detecting a serving system node change request from an intercepted target towards a serving system node which is currently not serving the target;

- processing said serving system node change request at said new serving system node currently not serving the target, wherein said processing comprises the inclusion, to the request, of a serving system address of the serving system node currently not serving the target;

- forwarding said processed request to an serving system node currently serving the target to inform an interception system of the serving system address of the serving system node currently not serving the target;

- detecting, at the new serving system node currently not serving the target, at least one active communication context for said target,

- generating a communication context update request to which is included the new serving system address of the serving system node currently not serving the target, and

- forwarding said generated request to a gateway serving system node of the serving system currently serving the intercepted target to inform the interception system.

In contrast to claim 1, Josse discloses a data packet radio service with enhanced mobility management. Although Josse describes a protocol for inter SGSN routing area updates (FIG. 4A), Josse is completely silent with respect to providing a protocol to inform an interception system of serving system information (e.g., "serving system address") when roaming occurs, much less a protocol with double "detecting" as recited above in claim 1. At best, Josse discloses the use of an allegedly "new" GPRS Tunneling Protocol message to provide an update when a routing area update is sent by the mobile (e.g., during power up). Josse, col. 11, lines 21-43.

¹ Canceled claims have been omitted.

Moreover, Sjoblom discloses a mechanism to order the packets in a system associated with a law enforcement intercept system. Although Sjoblom discloses that the law enforcement intercept system may be coupled to a GSN, Sjoblom suffers from the same deficiencies as Josse, i.e., offering no clue with respect to providing a protocol to inform an interception system of serving system information, much less a protocol with double "detecting" as recited above in claim 1.

In view of the foregoing, neither Josse nor Sjoblom discloses or suggests at least the following features of claim 1: "detecting a serving system node change request from an intercepted target towards a serving system node which is currently not serving the target," and "detecting, at the new serving system node currently not serving the target, at least one active communication context for said target." Therefore, claim 1 is allowable over Josse and Sjoblom, whether taken alone or in combination, and the rejection of claim 1 as well as claims 5-7, at least by reason of their dependency, under 35 U.S.C. § 103(a) should be withdrawn.

Because Josse and Sjoblom fails to disclose the double detecting noted above, Josse and Sjoblom cannot possibly disclose the corresponding forwarding, much less "forwarding said processed request to an serving system node currently serving the target to inform for informing an interception system of the serving system address of the serving system node currently not serving the target," and "forwarding said generated request to a gateway serving system node of the serving system currently serving the intercepted target to inform the interception system." Therefore, claim 1 is allowable over Josse and Sjoblom, whether taken alone or in combination, and the

rejection of claim 1 as well as claims as well as claims 5-7, at least by reason of their dependency, under 35 U.S.C. § 103(a) should be withdrawn for this additional reason.

Independent claims 8 and 14, although of different scope, include features similar to those noted above with respect to claim 1. For at least the reasons given above with respect to claim 1, claims 8 and 14 are allowable over Josse and Sjoblom, whether taken alone or in combination, and the rejection under 35 U.S.C. § 103(a) of claim 8 and 14 as well as claims 10-12, at least by reason of their dependency, should be withdrawn for this additional reason.

The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Josse, Sjoblom, in view of Miettinen. Applicants respectfully traverse this rejection.

Claim 4 depends from claim 1 and includes all of the features recited therein. For at least the reasons noted above with respect to claim 1, claim 4 is allowable over Josse and Sjoblom. Moreover, although Miettinen discloses correlation numbers for lawful interception, Miettinen fails to cure the above-noted deficiencies of Josse and Sjoblom. Therefore, claim 4 is allowable over Josse, Sjoblom, and Miettinen, whether taken alone or in combination, and the rejection of claim 4 under 35 U.S.C. § 103(a) should be withdrawn.

The Examiner rejected claims 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Josse, Sjoblom, in view of Neumann. Applicants respectfully traverse this rejection.

Claim 7 depends from claim 1 and includes all of the features recited therein. For at least the reasons noted above with respect to claim 1, claim 7 is allowable over Josse and Sjoblom. Claim 13, although of different scope, includes features similar to

those of claim 7. Moreover, although Neumann discloses paging, it fails to cure the above-noted deficiencies of Josse and Sjoblom. Therefore, claim 7 and 13 are allowable over Josse, Sjoblom, and Neumann, whether taken alone or in combination, and the rejection of claim 4 under 35 U.S.C. § 103(a) should be withdrawn.

Regarding the motivation to combine, M.P.E.P. 2143.01 states “[i]f **proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.**” *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), Emphasis Added. The intended purpose of Josse is to introduce allegedly new messages, as described Josse's Summary of the Invention. To make the modifications to Josse, as proposed by the Examiner, would make Josse unsatisfactory for its intended purpose. Therefore, Applicants submit that one of ordinary skill in the art would not be motivated to make the Josse-Sjoblom combination proposed by the Examiner. Nor would one be motivated to make the Josse-Sjoblom-Miettinen and the Josse-Sjoblom-Neumann combinations. Therefore, the rejections under 35 U.S.C. § 103(a) of the pending claims should be withdrawn for this additional reason.

CONCLUSION

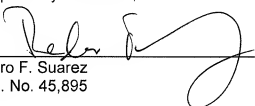
Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner. Applicants submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner. Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner continue to dispute the patentability of the pending claims.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant is concurrently filing herewith a Petition for a one-month extension of time with the requisite fee. Authorization for a credit-card payment of the filing fees mentioned above is submitted herewith. No additional fees are believed to be due, however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 39700-582N01US/NC16997US. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

Date: 30 July 2009



Pedro F. Suarez
Reg. No. 45,895

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
3580 Carmel Mountain Road
Suite 300
San Diego, CA 92130
Customer No. 64046
Tel.: (858) 314-1540
Fax: (858) 314-1501